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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,828	06/11/1999	WALTER GUENTER	GUENTER-1(P	3616

7590

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EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

20

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/319,828

Applicant(s)

GUENTER, WALTER

Examiner

Sheeba Ahmed

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 15, 18-20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 15, 18-20, and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 30, 2003 has been entered.

Response to Amendment

2. Amendments to claims 15, 23, and 33 have been entered in the above-identified application. Claims 17 and 21 have been cancelled. **Claims 15, 18-20, and 22-31 are now pending.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15, 19, 20, 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkie (US 5,981,047).

Wilkie discloses a co-extruded polyolefin packaging film comprising a core layer having a cold seal release layer (**corresponding to the plastic film of the claimed invention**) formed thereon (Column 3, lines 47-51). The release layer composition comprises polybutylene, a second polymeric blend, and non-migratory slip agent (**corresponding to the materials having release properties towards adhesives and meeting the limitation that such materials do not diffuse into an adhesive when the plastic film is disposed next to an adhesive**) in an amount sufficient to decrease the coefficient of friction of the release layer (**indicating that the slip agent is embedded in the polymeric materials and thus meeting the limitations of claim 19**). Examples of such non-migratory slip agents include cross-linked silicone particles (**corresponding to the silicone compound of the claimed invention as recited in claim 15**) and various inorganics such as talc, silica, glass beads and clay (**corresponding to the inorganic fillers of the claimed invention as recited in claim 20**) (Column 5, lines 25-31, lines 56-67 and Column 6, lines 1-3). A matte-finish film surface can be obtained by embossing (**thus meeting the limitations of claims 29 and 30**) (Column 2, lines 54-58). In light of the Specification and the explanation provided by the Applicants on Page 5 of the Response submitted on January 30, 2002, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers and since the cold seal release film disclosed by Wilkie can be co-extruded, the Examiner takes the position that the cold seal release layer disclosed by Wilkie meets the "self-carrying" limitation. All limitations of claims 15, 19, 20, and 23-30 are disclosed in the above reference.

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4. Claims 23 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ooms et al. (US 5,942,557).

Ooms et al. disclose release coating compositions and films formed therefrom **(corresponding to the plastic film of the claimed invention)** comprising an epoxy functional polyorganosiloxane and highly crosslinked silicone resin particles **(corresponding to the materials having release properties towards adhesives and meeting the limitation that such materials do not diffuse into an adhesive when the plastic film is disposed next to an adhesive)** (Column 1, lines 48-52). The polyorganosiloxane is mixed with the silicone resin particles and coated on a substrate and cured by exposure to UV light **(thus meeting the limitation that the polymers adapted to form the plastic film and the materials having release properties are mixed to form a mixture and then subsequently polymerized to incorporate the material having release properties as additives)** (Column 4, lines 36-43). Laminates of a pressure sensitive adhesive tape and polypropylene substrate coated with the release formulation were prepared **(thus meeting the limitations of claim 31)** (Column 3, lines 46-50). All limitations of claims 23 and 31 are disclosed in the above reference.

5. Claims 15 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins (US 5,932,352).

Higgins discloses a release film comprising a polymeric film substrate and a release layer **(corresponding to the plastic film of the claimed invention)** formed from a silicone resin **(corresponding to the material having release properties**

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towards adhesives and meeting the limitations that such a material is a silicone compound and does not diffuse into an adhesive when the plastic film is disposed next to an adhesive) and a curable polymer (Column 1, lines 57-61). The silicone resin may be a polysiloxane (Column 4, lines 35-37). The release film may vary in thickness depending on the application and may be in the range of 5 to 350 μ m (***thus meeting the limitation of claim 22)*** (Column 8, lines 43-48). In light of the Specification and the explanation provided by the Applicants on Page 5 of the Response submitted on January 30, 2002, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers and since the release film disclosed by Higgins could be co-extruded, the Examiner takes the position that the release film disclosed by Higgins meets the "self-carrying" limitation. Furthermore, the Examiner interprets the limitation that the material having release properties is extruded together with the plastic film to be a process limitation and the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic film) is the same despite the process limitations of extruding given that the material having release properties is bound within the film. All limitations of claims 15 and 22 are disclosed in the above reference.

6. Claims 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Adamko et al. (US 5,948,517).

Adamko et al. disclose release films (***corresponding to the plastic layer of the claimed invention***) made of thermoplastic materials such as a blend of two or more LLDPE's (***wherein one component corresponds to the polymer comprising the polymer film and the other corresponds to the polyolefin additive material of claim 18***) that may be applied to a polymeric adhesive surface (Column 3, lines 15-18 and Column 4, lines 60-64). The invention may be a pressure sensitive adhesive tape having an adhesive layer and a release film liner. The film may be cast or extruded and preferably has a thickness of 0.01 to 0.5 mm (Column 5, lines 45-48).). In light of the Specification and the explanation provided by the Applicants on Page 5 of the Response submitted on January 30, 2002, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers and since the release film disclosed by Adamko et al. could be co-extruded, the Examiner takes the position that the release film disclosed by Adamko et al. meets the "self-carrying" limitation. Furthermore, the Examiner interprets the limitation that the material having release properties is extruded together with the plastic film to be a process limitation and the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic film)

is the same despite the process limitations of extruding given that the material having release properties is bound within the film. All limitations of claim 18 are disclosed in the above reference.

Response to Arguments

7. Applicant's arguments filed On January 30, 2003 have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 15 and 22 under 35 U.S.C. 102(e) as being anticipated by Higgins (US 5,932,352) and submit that Higgins fails to recite a self-carrying layer. However, as pointed out above in Paragraph No. 5, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers and since the release film disclosed by Higgins could be co-extruded, the Examiner takes the position that the release film disclosed by Higgins meets the "self-carrying" limitation.

Applicants further traverse the rejection of claim 18 under 35 U.S.C. 102(e) as being anticipated by Adamko et al. (US 5,948,517) and submit that claims 15, 18-20, and 22-31 are all directed to a silicone-free release film. However, the Examiner disagrees. Claims 18 and 20 specifically state that the material having release properties comprises polyolefin compounds and inorganic fillers, respectively.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-

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0594. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.



Sheeba Ahmed
Art Unit 1773
March 10, 2003